

## **REMARKS**

Applicants respectfully request reconsideration of the instant application in view of the foregoing amendments and the following remarks. Claims 1-9, and 11 are pending in this application. Claim 10 was previously canceled. Claims 1 and 11 are the only independent claims. Claims 1 and 11 have been amended. No new matter has been added by this amendment.

### **Rejection Under 35 USC § 101**

In the Final Office Action claims 1-9, and 11 are rejected under 35 U.S.C. § 101 as allegedly been directed to nonstatutory subject matter. More specifically, it is alleged in the Office Action that "a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing." (See, December 30, 2008 Office Action, p. 2, para. 3). Applicants respectfully traverse the Examiner's rejection. Applicants respectfully submit that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. Per MPEP § 2106, Section IV, the Office Action is instructed to "[d]etermine whether the claimed invention complies with 35 U.S.C. 101." MPEP § 2106, IV(B)(1)(a-c) establishes three categories for Non-Statutory subject matter:

- a). Functional Descriptive Material;
- b.) Nonfunctional Descriptive Material; and
- c.) Natural Phenomena Such as Electricity and Magnetism.

Applicants submit that the elements recited in noted claims are, in fact, directed to statutory subject matter and are not precluded by any of the established categories of Non-Statutory subject matter. More specifically, a processor-implemented method, may tangibly

hold and execute the elements described in the claims without any energy. Though Applicants respectfully traverse the Examiner's rejection and reserve the right to argue patentability of the claims in their original form at a later time, Applicants have amended independent claims 1 and 11 to provide clarification and/or to better track business practices. Independent claims 1 and 11 recite, "A processor-implemented method of identifying billing discrepancies . . .," and, " comparing by a processor. . . ." Applicants submit that support for the amendments may be found throughout the originally filed specification, drawings, and claims, and that no new matter has been added by way of this amendment. Accordingly, for at least these reasons, Applicants submit that independent claims 1 and 11 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Furthermore, Applicant submits claims 2-9, which are directly or indirectly dependent from independent claim 1, are also directed to statutory subject matter for at least similar reasons as those discussed above for independent claim 1. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection for these claims as well.

### **Claim Rejections — 35 USC § 103**

Claims 1, 2, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al. (U.S. Patent Publication No. 2002/0082991) (hereafter "Friedman") in view of Nelson (U.S. Patent No. 6,032,132) and Pintsov (U.S. Patent Publication No. 2003/0036918). Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman in view of Nelson and Pintsov and in further view of Zai (U.S. Patent No. 6,975,208). Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman in view of Nelson and Reding et

al. (U.S. Patent Application No. 5,822,414) (hereafter "Reding"). Applicants respectfully traverse the Examiner's rejections and submit that a *prima facie* case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

**I. Applicants submit that a prima facie case of obviousness has not been established**

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Final Office Action do not establish each of these requirements.

Applicants submit that the rejections in the December 30, 2008 Final Office Action do not address every claim limitation to establish the differences in the claim over the applied references and over-generalizes cited references. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. The Examiner has failed to comply with this.

Applicants submit that the pending rejection has cited no reference nor taken Official Notice with respect to several elements of the pending claims. By way of example only, Applicants note that the pending rejection has cited no reference nor taken Official Notice with respect to the claim limitations of claim 1 and 11 that recite "said billing data including an

assessed fee and call details associated with each of a plurality of calls made by a customer."

The Final Office Action has cited paragraph 0032 and 0036 of Friedman in rejecting the "receiving billing data from a billing entity, said billing data including an assessed fee and call details associated with each of a plurality of calls made by a customer" as recited in claim 1.

The cited portions of Friedman in its entirety state:

Turning to FIG. 3 the overall bill reconciliation process flow of the preferred embodiment is shown. Generally, bill reconciliation involves data input, analysis and reporting. In order to initiate the billing reconciliation process, first billing data must be input to system 10. Depending on the format of the bills and related information, data can be entered in several methods both electronically 100 and manually 102. Additionally, OSS ("Operations Support Systems) data, reflecting the customer's internal records with respect to telecommunications purchases, are loaded 104 into system 10. The data input to system 10 is then used to prepare and transmit consolidated invoices to accounts payable 106 and analyze the billing data 108.  
Friedman, page 2, paragraph 0032.

Electronic Bills: Referring now to FIGS. 4a-c, shown in detail are the electronic bill loading process flows. Vendors (e.g., Telco's) provide bills for wholesale services in a number of different formats, which fall into one of two categories: CABS (carrier access bills) and non-CABS (such as GTE E. Solutions and US West Bill Mate).  
Friedman, page 3, paragraph 0036.

These cited sections of Friedman do not disclose that said "billing data including an assessed fee and call details associated with each of a plurality of calls made by a customer" as recited in the claims. (Emphasis added). Accordingly, Applicants submit that the pending rejection fails to consider "all words in [the] claim," as required, for example, by MPEP § 2143.03.

As another example, the Final Office Action on page 4 has failed to cite a reference in rejecting claim 1 limitations of "generating a database of the discrepancies," or "determining whether calls have discrepancies based on length of each of the calls," or

"characterizing at least one of the discrepancies as misapplication of a time dependent charge if a proportion of the **discrepancies does not vary with length of the calls** with discrepancies." (Emphasis added). The Examiner in the Final Office Action has only summarized Nelson and Pintsov and has not discussed what cited portions of the references read on these claim limitations. Similarly, on pages 12-15 of the Final Office Action, the Examiner has characterized the cited references but has failed to show a cited reference, alone or in combination, to read on the elements of the claims. Applicants respectfully request that the Examiner's rejection adhere to the language actually recited in the claims and substantively address all recited claim elements. Otherwise, Applicants cannot be sure if, which, and/or to what claim limitations the rejection is addressing or asserting equivalents towards.

Because every limitation of claims 1 and 11 are not addressed in the pending rejection, the differences in the claim over the applied references can not have been established, therefore, a *prima facie* case of obviousness has not been established under 35 U.S.C. § 103. Applicants assert that the claimed elements are absent in the cited references and the Examiner has failed to show and/or particularly point out (as required) all elements of the claims. Accordingly, for at least these reasons, Applicants submit that independent claims 1 and 11, as well as the claims directly or indirectly dependent therefrom, are allowable.

## **II. The pending claims are patentably distinct from the cited references**

MPEP § 2142 provides that, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Applicants contend that a *prima facie* case of obviousness has not been established for at least the reasons given above. Nevertheless, Applicants have provided the following discussion in an effort to provide clarification of the claim elements and expedite further prosecution. Applicants

maintain that the claims in their original form are not anticipated or rendered obvious by the cited references taken alone or in combination and reserve the right to return to that form and argue patentability at a later time.

Claims 1 and 11 recite "receiving billing data from a billing entity", where the **"billing data includ[es] an assessed fee and call details associated with each of a plurality of calls made by a customer."** (Emphasis added). The Final Office Action on page 3 has cited has cited paragraph 0032 and 0036 of Friedman in rejecting these limitations. However, the cited portions of Friedman merely discuss "the overall bill reconciliation" where "bill reconciliation involves data input, analysis and reporting." (Friedman, page 2, paragraph 0032). Another cited portion of Friedman discusses "the billing reconciliation process" where "billing data must be input to system 10." These portions of Friedman do not teach that "billing data includ[es] an assessed fee and call details associated with each of a plurality of calls made by a customer" as required by claims 1 and 11.

Further, the Final Office Action has cited to the portion of Friedman that discusses electronic bills where "Vendors (e.g., Telco's) provide bills for wholesale services in a number of different formats, which fall into one of two categories: CABS (carrier access bills) and non-CABS (such as GTE E. Solutions and US West Bill Mate)." Friedman, page 3, paragraph 0036. This cited portion of the Friedman also fails to disclose "billing data includ[es] an assessed fee and call details associated with each of a plurality of calls made by a customer" as recited by independent claims 1 and 11. For at least this reason, claims 1 and 11 are allowable.

Claim 1 recites "generating a database of the discrepancies." The Examiner has failed to address the limitation of "generating a database of the discrepancies" in regards with

claim 1 and has not cited any reference. For at least this reason claim 1 is in condition of immediate allowance.

Claims 1 further recites "determining whether **calls have discrepancies based on length of each of the calls**" and "characterizing at least one of the discrepancies as misapplication of a time dependent charge **if a proportion of the discrepancies does not vary with length of the calls with discrepancies.**" (Emphasis added). The Examiner on page 4 of the Final Office Action admits that Friedman fails to disclose these limitations and has cited Nelson and Pintsov to cure these deficiencies. The Examiner, on page 12 of the Final Office Action, asserts that Pintsov teaches "running queries against call details associated with calls having discrepancies to determine whether overall charge for the calls having discrepancies that varies based on length of each of the calls having discrepancies." The Examiner cites paragraph 0066-0067 and 0077 of Pintsov and specifically refers to Pintsov's mention of a "systematically observed difference". However these paragraphs discuss comparing billing results obtained, respectively, by a customer's trusted self-billing system and by the utility company's (telephone company's) own billing system. The passage mentions that a "systematically observed difference" between the results obtained by the two systems may indicate that one of the two systems is not functioning properly. However, these cited portions do not disclose "determining whether calls have discrepancies based on length of each of the calls" as recited by claim 1.

The Examiner in the Final Office Action maintains that paragraph 77 of Pintsov combined with Friedman and Nelson teach "characterizing at least one of the discrepancies as misapplication of a time dependent charge if a proportion of the discrepancies does not vary with length of the calls with discrepancies" as recited by claim 1. However, the cited portion of

Pinstov, in its entirety, merely states that if "there are no missing records (step 462), it is then determined whether the billing file is based on a rates plan file that is different from that used by the utility service provider (step 464). If the billing file is based on a different rates plan file, then the diagnostic (step 454) and subsequent steps are executed to determine the source and cause of the discrepancy, as well as to determine whether the discrepancy is deliberate." This section at best discusses determining different rates plan files but does not disclose "characterizing at least one of the discrepancies **as misapplication of a time dependent charge if a proportion of the discrepancies does not vary with length of the calls** with discrepancies" as required by claim 1. Therefore, Pinstov and Nelson fail to cure the deficiencies of Friedman rendering claim 1 allowable.

As such, Applicants respectfully submit that amended independent claim 1 is distinct over the over the applied references of Friedman, Pinstov and Nelson, alone or in combination, for at least the reasons given above. Applicants submit that, inasmuch as claims 2-9 directly or indirectly depend from independent claims 1, they are patentably distinct over the applied references for at least the reasons given above. Accordingly, Applicants respectfully request withdrawal of rejections of these claims.

In addition to the elements and limitations of claim 11 discussed above, claim 11 further recites "identifying discrepancies of substantially a fixed amount to determine calls placed from a public pay phone." In the Final Office Action, the Examiner admits that the combination of Friedman and Nelson fails to teach these limitations and has cited Reding to cure this deficiency. The Examiner has cited col. 1, lines 25-29 and lines 46-54 of Reding in making the rejection, however, these sections merely state that "any discrepancies between the actual charged rate and the reference rate are recorded in the



production database and the record found to have potential discrepancies is book marked" and the "discrepancy information that was generated in the validation process may then be used in a dispute management process." (Reding, col. 1, lines 25-29 and lines 46-54).

This section does not teach "identifying discrepancies of substantially a fixed amount to determine calls placed from a public pay phone" as recited by claim 11. Thus this deficiency in Friedman/Nelson remains uncompensated for by the Reding reference.

Therefore, claim 11 is allowable for this additional reason. Applicants respectfully request that the Examiner withdraw the pending rejections, since claim 11 is patently distinct from the combined teachings of the references.

### **Conclusion**

Consequently, the reference(s) cited by the Final Office Action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-9 and 11, all: overcome all rejections and/or objections as noted in the Final Office Action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further,

any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-330. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-330.

Respectfully submitted,  
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